

REMARKS/ARGUMENTS

Applicants would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office Action and the personal interview, and it is respectfully submitted that the application as amended is patentable over the art of record. Reconsideration of the application as amended is respectfully requested.

Claims 1–9 remain in this application. Claim 4 has been amended to put the claim into independent format.

Claim 4 has been objected to, but the Examiner has indicated that claim 4 would be allowable if put into independent format. Claim 4 has been put into independent format, and thus is allowable.

Claims 1–2, and 5–8 were rejected under 35 U.S.C. 102(e) as being anticipated by Inoue *et al.* (U.S. Patent No. 6,618,586). Claims 3, 5, and 6 were rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue in view of Yasuda *et al.* (U.S. 5,062,132). For the following reasons, the Examiner's rejections are respectfully traversed.

As discussed at the personal interview, the references do not teach the “temporary storage memory” and the “plurality of telephone directories including a plurality of user selectable directories user selectable for storing user selected phone numbers” which are “associated with at least one telephone directory memory different from said temporary storage memory” as recited in amended claim 1. Amended claim 9 recites similar limitations.

Applicant's representative discussed the differences between the invention and the cited prior art with the Examiner at the personal interview. The Examiner expressed concern that it was not clear from the claim language that the plurality of directories were selectable by the user,

or that they were different from the temporary storage directory of the reference. Thus, claims 1 and 9 were amended to clarify this aspect of the claims.

Accordingly, as was further discussed at the personal interview, the amended language is clearly not taught by the reference, because a thorough review of the reference shows repeated references to “a directory memory” or “the directory memory 6,” but not a single reference to more than one directory. Furthermore, because the temporary storage of claims 1 and 9 use a temporary storage memory, whereas the user selectable directories of the claim use one or more memories different from the temporary memory, it is clear that the user-selectable directories cannot include the temporary storage function. Consequently, the Inoue reference does not teach the ability for a user to select among a plurality of user selectable memories associated with one or more memories different from the temporary memory, as recited in the claims.

This is clear from Fig. 2 of the reference, which shows both a directory memory 6, and a temporary memory 7. If both are considered user selectable (although there is no suggestion of such user selectability in the reference), then the reference does not teach a memory corresponding to the temporary memory of the claims. In contrast, if memory 7 is considered to correspond to the temporary memory of claim 1, then that directory cannot correspond to one of the user-selectable memories of the claim. Accordingly, the claims are patentable over the reference.

In addition, the reference does not teach the limitation of claim 1, which recites that a “telephone number stored in the temporary storage memory is registered in one of said at least one telephone directory memory associated with one of said user selectable directories selected from the plurality of telephone directories after making a call.” Claim 9 recites similar

limitations. The reference fails to teach these limitations of the claims, and thus claims 1 and 9 are patentable over the reference for this reason as well.

The reference teaches that a temporary storage memory 7 is used for “temporarily storing a telephone number of a party” (col. 4, lines 46–47). The Inoue device then can notify the user whether the telephone number is in *the* directory memory 6, and if not, the user can choose to have that telephone number stored in *the* directory memory 6 (see generally col. 5 of the reference). Thus, the reference teaches only a single directory, whereas the claims all recite a plurality of user selectable directories.

The Examiner, in the Office Action, attempts to overcome this shortcoming by calling the temporary memory 7 a directory. He states that “[f]or clarity, the temporary memory 7 is considered both the temporary storage memory and one of the plurality of user selectable telephone directories associated with a telephone directory memory.” But the Examiner fails to provide any citations teaching this assertion, and Applicant’s representative could find none. It is clear that, at most, the temporary memory of Inoue corresponds to the temporary memory of claims 1 or 9 at lines 3–4. There is no suggestion in the reference that this temporary memory is used as any directory, and even if it were, there is no suggestion that the temporary directory is user-selectable.

Furthermore, the reference does not teach *any* “user selectable directories” at all, because there is only a *single* directory disclosed by the reference. The user has no choice of directories, and thus cannot choose one. Instead, the user merely chooses whether an unstored number can be stored. Thus, the user chooses to store or not store a telephone number. But there is no “selection” of directories taught. The Examiner, in the Office Action, attempts to show a “selection” when he states that “the directory memory 6 must be *selected* before registering after

a call.” But that is not what the references teaches. Instead, the reference teaches that the user may be given the option of storing the number in the directory memory. There is no “selection” because there is only a single directory. The claim language specifically provides that “a telephone number stored in the temporary storage memory is registered in one of said at least one telephone directory memory associated with *one of said user selectable directories selected from the plurality of telephone directories after making a call.*” This language cannot read on the reference because the reference teaches only a single directory, and thus there is nothing for the user to select from.

The Yasuda reference does not overcome the Inoue shortcomings. Thus, claims 1 and 9 are patentable over the reference. The remaining rejected claims are patentable over the references because they depend, directly or indirectly, on claim 1.

Finally, there is no suggestion or motivation for one skilled in the art at the time the invention was made to combine the references to arrive at the claimed invention or to apply the features of which the Examiner has taken Official Notice.

Instead, the Examiner relies on the benefit of the secondary reference or the feature as motivation for making the modification to the primary reference. This, of course, is not proper, because that would then make any reference self-motivating, and that is clearly not the law. Even if the Examiner’s taking of Official Notice is proper, there must be some motivation for making the modification. Accordingly, the rejections for obviousness should be withdrawn.

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

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Respectfully submitted,

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